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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 18

Application Number: 09/942,199
Filing Date: August 29, 2001
Appellant(s): ANVICK, MARK S.

Kenneth W. Float
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06 November 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The Examiner agrees with the appellant's statement that claims 1-17 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,114,265	Grisley	5-1992
4,809,755	Pontikas	3-1989

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grisley in view of Pontikas. This rejection is set forth in a prior Office Action, Paper No. 12. This rejection is supported by the following findings:

Findings

1. Grisley shows and discloses (see figures 4, 5 and 8) a first flat member **13**.

2. Grisley shows the first flat member **13** having a predetermined shape, first and second opposed flat surfaces (top and bottom surfaces of **13**), and a first predetermined thickness (i.e. the thickness of the first flat member **13** between the top and bottom surfaces).

3. Grisley shows a cavity **24** formed in the first member **13**.

4. Grisley shows the cavity **24** having a predetermined inner partially curved contour (see figures 4 and 5) that is exposed at the first flat surface of the first flat member **13** (i.e. open at the top surface) and along a portion of an edge of the first flat member **13** (i.e. the front edge of member 13).

5. Grisley further shows the cavity **24** has a depth that extends a predetermined distance below the first flat surface (**see figures 5 and 8**), and wherein the depth of the

cavity **24** is a predetermined portion of the thickness of the first member **13** (**see figures 5 and 8**; column 3 line 63 – column 4 line 34).

6. Grisley shows a second flat member **12** (see figures 4, 5 and 8).

7. Grisley shows the second flat member **12** having a predetermined shape, first and second opposed flat surfaces (top and bottom surfaces of **12**), and a second predetermined thickness (i.e. the thickness of the first flat member **13** between the top and bottom surfaces).

8. Grisley shows the second flat member **12** having a tab **22** with an outer partially curved contour (see figures 4 and 5) that substantially matches the inner contour of the cavity **24** in the first flat member **13** so that the tab **22** fits within the cavity **24**.

9. Grisley further shows said tab **22** having a thickness that substantially matches the depth of the cavity **24** formed in the first flat member **13** (see figures 4 and 5; column 4 lines 35-38).

10. Grisley shows and discloses that said first **13** and second **12** members, when joined, lie in the same plane (see especially figures 5 and 8; column 4 lines 11-14).

11. Grisley shows and discloses the thicknesses of the first **13** and second **12** members are substantially the same (see figure 5).

12. Grisley shows the depth of the cavity **24** and the thickness of the tab **22** are substantially the same (see figures 4, 5 and 8).

13. Grisley shows the inner partially curved contour of the cavity **24** and the outer partially curved contour of the tab **22** have the shape of a piece of a puzzle as well as the shape of a molar tooth (see figures 4 and 5).

14. Grisley lacks explicit disclosure of the first **13** and second **12** members, when joined, being disposed at a predetermined noncollinear angle with respect to each other.

15. Pontikas teaches first **114** and second **116** members, when joined, being disposed at a predetermined noncollinear angle with respect to each other (see figure 20).

16. Pontikas teaches joining coplanar members 114,116 at a predetermined noncollinear angle in order to provide an angled joint (see figure 20; column 6 lines 61-68).

(11) Response to Argument

All of the rejections are under 35 U.S.C. §103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, e.g., In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

As set forth in the rejection of claims 1-17 and findings 1-16 above, Grisley shows and discloses every limitation recited in the claims, including that the first **13** and second **12**

members, when joined, lie in the same plane (see figures 5 and 8; column 4 lines 11-14). Grisley *does not* teach the first **13** and second **12** members, when joined, being disposed at a predetermined non-collinear angle with respect to each other. Pontikas, however, teaches first **114** and second **116** members that, when joined, lie in the same plane (figure 20) and are disposed at a predetermined noncollinear angle with respect to each other in order to provide an angled joint (see figure 20; column 6 lines 61-68). One of ordinary skill in the art would be motivated by the general description of Pontikas to arrange plural members in an angled orientation depending on the particular application of the joint (see column 2 lines 59-62; figures 13-15 and 18-20).

In view of the aforementioned combination of Grisley in view of Pontikas, the Examiner maintains that a prima facie case of obviousness has been established in accordance with the well-recognized standards set forth above.

Response to Specific Arguments

The Appellant argues that the Grisley patent does not disclose or suggest that "the first and second flat members, when joined, lie in the same plane and are disposed at a predetermined noncollinear angle with respect to each other." (Brief, page 3 third full paragraph.) Referring back to the rejection of the claims, the Examiner asserts that Grisley shows the first **13** and second **12** members, when joined, lie in the same plane (see figures 5 and 8), but agrees that Grisley does not show the first and second flat members, when joined, being disposed at a predetermined noncollinear angle with respect to each other. However, the Examiner has not relied upon Grisley to disclose this limitation of the claim. Rather, the Examiner relies on the teachings of Pontikas wherein the same type of joint is produced with both collinear and

noncollinear angles depending on the particular application or purpose of the joint (see Pontikas figures 20).

The Appellant goes on to argue that "the Grisley patent discloses a joint that is only used for joining members at 90 degree, or right, angles and does not produce a substantially flat frame structure. The Examiner disagrees and respectfully directs the Board's attention to Grisley figures 5 and 8 as well as to column 4 lines 11-14 which explicitly discloses "a 180° joint."

The Appellant further argues that "[i]n the instant invention, the cavity is formed in the first member that is *about one half the thickness* of the first member, and the mating, interlocking tab has a thickness that is *about one half the thickness* of the second member...." (emphasis added) (Brief, page 4, second full paragraph.) **It is noted that the features upon which applicant relies (i.e., those features shown in italics) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.** See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims recite that the "cavity has a depth that extends a predetermined distance below the first flat surface, and wherein the depth of the cavity is a predetermined portion of the thickness of the first flat member." The broad terms "predetermined distance" and "predetermined portion" seem to include any cavity depth up to and including the full depth of the member. The Examiner stresses that, despite the fact that the recited language does not preclude the cavity depth from extending through the full thickness of the first member, Grisley nevertheless also includes an embodiment wherein the cavity does not extend through the entire thickness of the first member (see figure 8). Thus, Grisley clearly meets the limitations set forth in the claims.

Response to General Arguments

In response to appellant's arguments that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Brief page 3, second full paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, Grisley discloses every limitation recited in the claims except for the first and second members, when joined, being disposed at a predetermined non-collinear angle with respect to each other. Pontikas clearly teaches that an angular, planar joint construction is well known in the art depending upon the particular application of the joint. As such, the Examiner respectfully disagrees with Appellant's argument of hindsight reconstruction.

The Examiner also explicitly notes that Appellant's arguments throughout the Brief are solely directed to the references individually. In response, the Examiner stresses that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejections are clearly based on the combination of Grisley in view of Pontikas. The Examiner maintains that the combination, as presented above, is proper and establishes a prima facie case of obviousness.

Other Relevant Prior Art

The Examiner also directs the Board's attention to a previously cited reference – Eberspacher (DE 4333089 A1). Eberspacher Figure 5 is deemed to be particularly relevant to the instant claims although it has not been applied formally at this point in the prosecution.

Conclusion

In sum, the Examiner maintains that the combination of Grisley and Pontikas includes each and every limitation set forth in the claims (see findings above). For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Examiner
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RMF
November 30, 2003

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